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KEVIN G. MIERZWA
ARTZ & ARTZ, P.C.
28333 TELEGRAPH ROAD, SUITE 250
SOUTHFIELD, MI 48034

EXAMINER

COLIN, CARL G

ART UNIT	PAPER NUMBER
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2133

DATE MAILED: 11/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/558,192

Applicant(s)

NARASIMHASWAMY ET AL.

Examiner

Carl Colin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 April 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2-6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. Pursuant to USC 131, claims 1-41 are presented for examination.

Specification

2. The disclosure is objected to because of the following informalities: on page 8, line 1, reference number "18" should be --28--. Appropriate correction is required.

Drawings

3. Figure 2 is objected to as failing to comply with 37 CFR 1.84(p)(5) because it does not include reference signs: reference number (10) in the description on p. 11, line 12. Appropriate correction is required.

A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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4.1 **Claims 1, 20, 27, and 33** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention lacks a computer system to exhibit the tasks mentioned in the above claims.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5.1 **Claims 1-41** are rejected under 35 U.S.C. 102(e) as being anticipated by Foreign Patent WO-01-08031 (21 July 1999) to **Morris et al.**

5.2 **As per claim 1, Morris et al.** discloses a method of forming an online invention disclosure comprising: forming an invention disclosure online by entering a plurality of selected

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information including a first inventor identification information (see figure 6a); as the plurality of selected information is entered, storing the selected information in a central storage location (see claim 1); and prompting approval of said first inventor (see figure 6b).

As per claim 12, Morris et al. discloses an invention disclosure system (see claim 1 and figure 3) comprising that meets the recitation of claim 12. A computer system comprises of a user computer, web server, database, and computer display. **Morris et al.** further discloses a user computer; a web server having an identification subsystem (see claim 1 and page 13, lines 1-17); a database coupled to the server (see figure 3); said server providing user screens to said users so users provide disclosure information to said server, receiving disclosure information from said users, storing information in said database, prompting the user to provide a password associated with said disclosure; and allowing access to said disclosure after storing said information in said database upon entering the password associated with the disclosure (see pages 13-14, 22).

As per claim 16, Morris et al. discloses a user computer; a server (see figure 3 and claim 1); a database coupled to the server (see figure 3); said server providing user screens to said users so users provide disclosure information to said server providing user screens to said users to prompt said users to provide disclosure information to said server, receiving disclosure information from said users including a first inventor identification and a second inventor identification, storing information in said database, prompting the first inventor and the second inventor to provide an approval (see page 22 and page 20 lines 10-11).

As per claim 20, Morris et al. discloses a method of forming an online invention disclosure comprising: forming an invention disclosure online by entering a plurality of selected information including a first inventor identification information and a second inventor identification (see page 13 and figure 4); as the plurality of selected information is entered, storing the information in a central storage location (page 9, lines 1-7 and page 11, lines 15-18); prompting approval of said first inventor; notifying the second inventor; and prompting the second inventor to approve the disclosure (see page 13 and claims 3 and 4); and locking the disclosure to create a locked disclosure to prevent further editing of the disclosure when the second inventor approves the disclosure (page 14, lines 1-10; page 11, line 12 et seq.; page 12). **Morris et al.** further discloses that electronic signature technology may be used when the inventors approve the disclosure, such electronic signature as disclosed by the inventor has the ability to lock the disclosure from further editing (see page 13, lines 1-17).

As per claim 27, Morris et al. discloses a method of forming an online invention disclosure comprising: entering a plurality of information including one or more inventor identifications from one or more inventors to form an invention disclosure (see page 13 and figure 4); storing the information in a central storage location (page 9, lines 1-7 and page 11, lines 15-18); prompting approval of the one or more inventors (page 14, lines 1-10; page 11, line 12 et seq.); locking the disclosure to create a locked disclosure to prevent further editing of the disclosure when the one or more inventors approve the disclosure (see claim 9; see also page 14, lines 1-10; page 11, line 12 et seq.). **Morris et al.** further discloses that electronic signature

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technology may be used when the inventors approve the disclosure, such electronic signature as well known in the art as disclosed by the inventor has the ability to lock the disclosure from further editing (see page 13, lines 1-17).

Claim 33 has the same limitation as the rejected **claim 27**. Therefore, **claim 33** is rejected on the same rationale as the rejection of **claim 27**.

5.3 **As per claims 2, 21, 28, and 34, Morris et al.** discloses the limitation of further comprising the step of generating an approval log (see page 21).

As per claims 3, 22, 29, and 35, Morris et al. discloses the limitation of wherein the step of generating an approval log comprises recording the date of an approval (see pages 13 and 21).

As per claims 4, 23, 30, and 36, Morris et al. discloses the limitation of further comprising associating the approval log with the disclosure (page 21).

As per claim 5, Morris et al. discloses the limitation of wherein forming is performed by a non-inventor author (see page 13).

As per claims 6 and 37, Morris et al. discloses the limitation of wherein the step of forming comprises identifying a second inventor; and further comprising the steps of notifying

the second inventor; and, prompting the second inventor to approve the invention disclosure (see page 13 and claims 3 and 4).

As per claims 7 and 38, Morris et al. discloses the limitation of further comprising revising the disclosure by the second inventor to form a revised disclosure, and prompting the first inventor to approve the revised disclosure (see page 13 and claims 3, 4, 82, and 83).

As per claims 8, 31, and 39, Morris et al. discloses the limitation of wherein prompting the second inventor comprises providing an E-mail to the second inventor (see page 16, lines 6 et seq.).

As per claim 9, Morris et al. discloses the limitation of wherein prompting comprises the step of prompting the approval of an associated document (see page 13, lines 18 through page 14).

As per claim 10, Morris et al. discloses the limitation of wherein said associated document is selected from a group consisting of an assignment document and a power of attorney (see page 26).

As per claim 11, Morris et al. discloses the limitation of further comprising allowing access to various users for obtaining the information (see page 13).

As per claim 13, Morris et al. discloses the limitation of further comprising a directory system coupled to said server whereby upon providing identification information to server said server retrieves user information from the directory system in response to the identification information (see page 11, lines 12 et seq.).

As per claim 14, Morris et al. discloses the limitation of wherein said server creates a user log (see page 12 line 1 et seq.).

As per claims 15, 17, and 18, Morris et al. discloses the limitation of wherein said server associates said approval log with said disclosure (see page 12).

As per claim 19, Morris et al. discloses the limitation of further comprising a directory system coupled to said server whereby upon providing identification information to server, said server retrieves user information from the directory system in response to the identification information (see page 11 and figure 2).

As per claims 24 and 40, Morris et al. discloses the limitation of further comprising locking the disclosure when the second user approves the disclosure (see claim 9; see also page 14, lines 1-10; page 11, line 12 et seq.).

As per claim 25, **Morris et al.** discloses the limitation of further comprising locking the disclosure when the first user approves the revised invention disclosure (see claim 9; see also page 14, lines 1-10; page 11, line 12 et seq.).

As per claims 26 and 32, **Morris et al.** discloses the limitation of wherein providing an E-mail to the second inventor comprises providing an E-mail to the second inventor having a hyperlink to the disclosure therein (see page 16, lines 6-10 and page 8, lines 8 et seq.). **Morris et al.** discloses making disclosure electronically accessible and using hyperlink to access disclosure.

As per claim 41, **Morris et al.** discloses the limitation of wherein said document is selected from a group consisting of an assignment document, an agreement and a power of attorney (see claim 36, see also page 26).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. US Patent 6,182,078 Whitmyer, Jr.

This patent pertains to a system to deliver professional services. Many of the claimed features, i.e. e-mail, log approval, etc. are disclosed in this reference.

b. Foreign Patent JP 11126223 A Takano et al.

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This patent pertains to a system to perform patent using communication networks such as the Internet. Many of the claimed features, i.e. approval between two inventors, invention notification, etc. are disclosed in this reference.

6.1. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carl Colin whose telephone number is 703-305-0355. The examiner can normally be reached on Monday through Thursday, 8:00-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on 703-305-9595. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

cc

Carl Colin

Patent Examiner

October 31, 2003

Eugene J. Lamarre
for

Albert DeCady
Primary Examiner